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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. SCHRAMM

Appeal 2008-004346
Application 10/092,878
Technology Center 1700

Decided: December 16, 2009

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
BRADLEY R. GARRIS and JEFFREY B. ROBERTSON, *Administrative
Patent Judges*.

ROBERTSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 21-45 and 47-54 (Appeal Brief filed October 13, 2007, hereinafter “App. Br.,” at 2; Final Office Action mailed December 6, 2006). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

STATEMENT OF THE CASE

Appellant's claimed invention relates to a spill-resistant container and a kit including, *inter alia*, the spill-resistant container that can be used, for example, for coloring eggs or for general painting (Specification, hereinafter "Spec.," 3). According to Appellant, the spill-resistant container has a low manufacturing cost so as to be considered disposable and provides convenience by avoiding the need to pour a liquid or paint powder concentrate into the container to use in coloring (Spec. 4-5).

Claims 21, 22, 26, 34, and 47 are illustrative:

21. A kit comprising the combination of a container, at least one work piece, at least one utensil, and a colorant, wherein said container includes an inner cavity, an exterior, an opening in a wall of said container and a funnel connected to said opening to provide communication between said inner cavity and the exterior of said container, and wherein said work piece, said utensil, and said colorant are at least partially removably contained within said container.

22. The kit of claim 21 wherein said work piece defines at least one colorable work piece of the following group of colorable work pieces consisting of a substantially egg shaped work piece, an edible work piece, a substantially egg shaped edible work piece, and an egg, and wherein said utensil defines at least one non-edible utensil of the following group of non-edible utensils consisting of a brush, a spoon, a device having a handle portion and a non-handle portion, a wire egg dipper, a pair of tongs, a straw, and a device for use in dipping eggs having a handle portion and an open loop portion, and wherein said colorant defines at least one colorant of the following group of colorants consisting of a colorant tablet, a predetermined quantity of powdered colorant, a discrete unit of colorant concentrate, and a colorant pill defining a colorant powder concentrate enclosed within a liquid soluble container.

26. The kit of claim 22 wherein said container includes at least one liquid flow channel formed in a wall of said container.

34. A kit comprising the combination of a container, non-fluid edible matter removably contained within said container, and at least one utensil at least partially removably contained within said container wherein said container includes an inner cavity, an exterior, an opening in a wall of said container and a funnel connected to said opening to provide communication between said inner cavity and the exterior of said container, and wherein said utensil defines at least one non-edible utensil of the following group of non-edible utensils consisting of, a brush, a spoon, a device having a handle portion and a non-handle portion, a pair of tongs, a straw, a wire egg dipper, a device for use in dipping eggs having a handle portion and an egg retention portion, and a device having a handle portion and an open loop portion.

47. A kit comprising the combination of a container, edible matter, and a utensil, wherein said container includes an inner cavity, an exterior, an opening in a wall of said container, and a non-annular funnel connected to said opening to provide communication between said inner cavity and the exterior of said container, and wherein said utensil and said edible matter are at least partially removably contained within said container.

(App. Br. 18-21; Claims App'x.)

The Examiner relied upon the following as evidence of unpatentability (Examiner's Answer mailed December 26, 2007, hereinafter "Ans.," 3):

McCombs	1,254,714	Jan. 29, 1918
Meth	3,464,599	Sept. 2, 1969
Price	3,840,678	Oct. 8, 1974
Ashton	4,438,564	Mar. 27, 1984
Fowler	4,921,713	May 1, 1990
McShane	4,967,687	Nov. 6, 1990
Law	5,074,239	Dec. 24, 1991
Lintvedt	5,143, 294	Sept. 1, 1992
Schramm	5,246,046	Sept. 21, 1993
Martindale	5,758,797	June 2, 1998
Hunter	GB 1,428,356	Mar. 17, 1976

Tomatsu¹

JP 11-227,388

Aug. 24, 1999

The Examiner rejected the claims as follows:

- I. Claims 22-27, 34-39, 40-45, and 47-51² under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Ans. 4-6);
- II. Claims 22-27, 34-39, 41, and 49 under 35 U.S.C. § 112, second paragraph, as indefinite (Ans. 6-7);
- III. Claims 21, 22, 24-28, 30-34, 36-45, and 47-51 under 35 U.S.C. § 103(a) as unpatentable over Law, Schramm, Hunter, Price, Martindale, and JP ‘388 (Ans. 8-12);
- IV. Claims 23, 29, and 35 under 35 U.S.C. § 103(a) as unpatentable over Law, Schramm, Hunter, Price, Martindale, JP ‘388, and Lintvedt (Ans. 12);
- V. Claims 47 and 48 under 35 U.S.C. § 103(a) as unpatentable over Law, Schramm, Hunter, Price, Martindale, and JP ‘388 and, if necessary, McShane (Ans. 12-13);
- VI. Claims 34, 36, 38, 39, and 47-49 under 35 U.S.C. § 102(b) as anticipated by Price (Ans. 13-14);
- VII. Claim 35 under 35 U.S.C. § 103(a) as unpatentable over Price and Lintvedt (Ans. 14);

¹ The Examiner and Appellant refer to Tomatsu as Japan 11-227388 and Japan ‘388. Thus, for consistency, we also refer to Tomatsu as JP ‘388.

² The Examiner rejected claims 22-24, 34-39, 40-45, and 47-51 (Ans. 4-6). While not explicitly stated, it is understood that dependent claims 25-27 are rejected as they depend from and therefore include the limitations of parent claim 22 (Ans. 4-6). Thus, the Examiner’s error in listing claim numbers is harmless.

- VIII. Claim 37³ under 35 U.S.C. § 103(a) as unpatentable over Price and Schramm (Ans. 14-15);
- IX. Claims 40-42, 44, and 45 under 35 U.S.C. § 102(b) as anticipated by McCombs (Ans. 15);
- X. Claim 43 under 35 U.S.C. § 103(a) as unpatentable over McCombs and Schramm (Ans. 15-16);
- XI. Claims 40 and 43-45 under 35 U.S.C. § 102(e) as anticipated by Martindale (Ans. 16-17);
- XII. Claim 42 under 35 U.S.C. § 103(a) as unpatentable over Martindale (Ans. 17);
- XIII. Claim 41 under 35 U.S.C. § 103(a) as unpatentable over Martindale and Lintvedt (Ans. 17); and
- XIV. Claims 52-54 under 35 U.S.C. § 103(a) as unpatentable over Price and Meth (Ans. 17-18).

We reverse Rejection II. However, we affirm Rejections I and III-XIV with respect to all claims except for claims 40 and 42-45 of Rejection I; claims 26, 32, 38, and 44 of Rejection III; claims 38, 47, and 48 of Rejection VI; and claim 44 of Rejections IX and XI.

A. 112, §§ 1 and 2

I. Claims 22-27, 34-39, 40-45, and 47-51: Lack of Written Description

The Examiner found, *inter alia*, that the claimed subject matter directed to: (i) a “non-annular funnel” (claim 47); (ii) “non-edible utensil”

³ In the Examiner’s Answer, the Examiner states claim 35 is rejected, but the Examiner’s rejection plainly addresses the subject matter of claim 37 (Ans. 14-15; claim 37). Accordingly, the Examiner’s typographical error is harmless.

(claims 22, 34, 48, and 49); and (iii) a utensil or device “having a handle portion and an open loop portion” (claims 22, 34, 41, 48, and 50) violate the written description requirement of 35 U.S.C. § 112, ¶1 (Ans. 4-6).

Appellant, on the other hand, argues that the originally filed Specification describes a funnel having an elliptical (i.e., “non-annular”) cross-sectional shape (App. Br. 6-7), and therefore, “non-annular funnel” does not contravene the written description requirement, regardless if it encompasses more configurations than the elliptical shape described in the Specification as filed (App. Br. 8). The Appeal Brief contains no arguments regarding the claimed subject matter identified at (ii) and (iii) above.

ISSUE

Thus, the issue arising from Appellant’s contentions is:

Has Appellant shown reversible error in the Examiner’s finding that the disclosure, as originally filed, does not reasonably convey to one skilled in the relevant art that Appellant had possession of the now claimed invention directed to: (i) a “non-annular funnel” (claim 47); (ii) a “non-edible utensil” (claims 22, 34, 48, and 49); and (iii) a utensil or device “having a handle portion and an open loop portion (claims 22, 34, 41, 48, and 50)”?

FINDINGS OF FACT (“FF”)

1. Appellant’s Figure 2 is reproduced below:

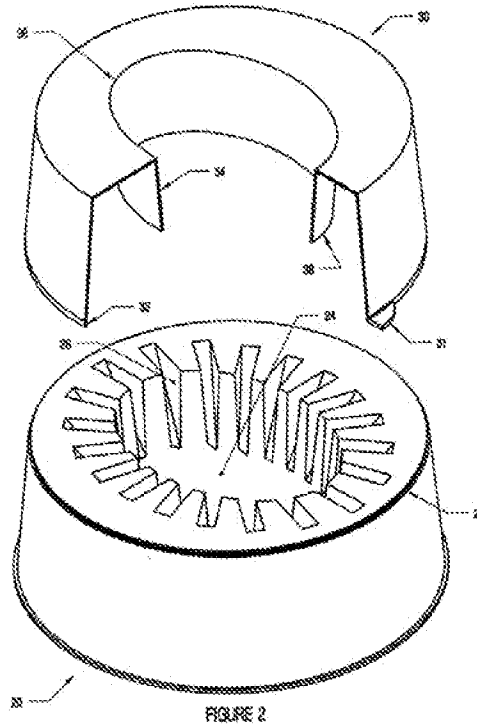


Figure 2 depicts a container that comprises a cup 20 having a plurality of flow channels 26 formed into the wall of the container (Spec. 4 and 6).

2. Appellant’s Specification, as originally filed, does not describe any other shapes of a funnel that is “non-annular,” other than an ellipse. (*See generally*, Appellant’s Specification, FF 1).

PRINCIPLES OF LAW

The proper test for determining whether claims comply with the written description requirement of 35 U.S.C. § 112, ¶ 1 is whether the originally filed disclosure of an application would have reasonably conveyed to one skilled in the art that the inventor had possession of the later claimed

subject matter. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). Additionally, a claim cannot be broadened when it is amended to include embodiments that are inconsistent with the original disclosure. *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1480 (Fed. Cir. 1998) (“[C]laims may be no broader than the supporting disclosure.”).

ANALYSIS

With regard to the phrase “non-annular funnel” (claim 47), Appellant contends that the originally filed disclosure supports the now claimed invention because it describes a funnel having an elliptical (i.e., non-annular) cross-section (App. Br. 8).

We are unpersuaded by Appellant’s contention. As asserted by the Examiner and acknowledged by Appellant, the now claimed invention encompasses more than an elliptically shaped funnel (Ans. 4-5; App. Br. 8-9). Indeed, Appellant states that the now claimed invention reads on a funnel having a rectangular cross-section (App. Br. 8). However, Appellant does not direct us to any evidence in the original disclosure that shows that a person skilled in the relevant art would have understood that the inventor had possession of a funnel having a rectangular cross-section (FF 1-2; Br. 4-15). Accordingly, Appellant has not demonstrated error on the part of the Examiner.

In the Appeal Brief, Appellant does not contest the Examiner’s determination that the subject matter of a “non-edible utensil” (claims 22, 34, 48, and 49) and a utensil or device “having a handle portion and an open loop portion” (claims 22, 34, 41, 48, and 50) fail to comply with the written

description requirement (Ans. 5-6).⁴ Therefore, Appellant has failed to demonstrate that the Examiner reversibly erred in rejecting these claims.

For these reasons, we uphold the Examiner's rejection of claims 22-27, 34-39, 41, and 47-51.

Regarding claim 40, it is apparent from the record that Appellant amended independent claim 40 (Amendment received June 26, 2006) to delete the phrase "unit of liquid dye concentrate" which the Examiner identified as failing to comply with the written description requirement of 35 U.S.C. § 112, ¶ 1 (Office action mailed April 19, 2006 at 4). Thus, we reverse the Examiner's rejection of claim 40 and dependent claims 42-45.

II. Claims 22-27, 34-39, 41, and 49: Indefiniteness

The Examiner asserted that the claim terms "discreet" (claim 49) and "potion" (claims 22, 34, and 41) cause the claimed invention to be indefinite because it is unclear how "discreet" further limits the claimed invention and it is unclear what a "potion" encompasses (Ans. 6-7).

ISSUE

Thus, an issue on appeal is:

When reading the claimed invention in light of the specification, would one of ordinary skill in the relevant art have understood the scope of the claimed invention, though the claims recite the claim terms "discreet" and "potion"?

⁴To the extent that arguments not found in the Appeal Brief are present for the first time in Appellant's Reply Brief filed on February 1, 2008 (Reply Br. 3-4), they are not timely and were waived upon filing of the Appeal Brief. See 37 C.F.R. § 41.37 (c)(1)(vii).

ADDITIONAL FINDINGS OF FACT (“FF”)

3. Appellant's Figure 3 is reproduced below:

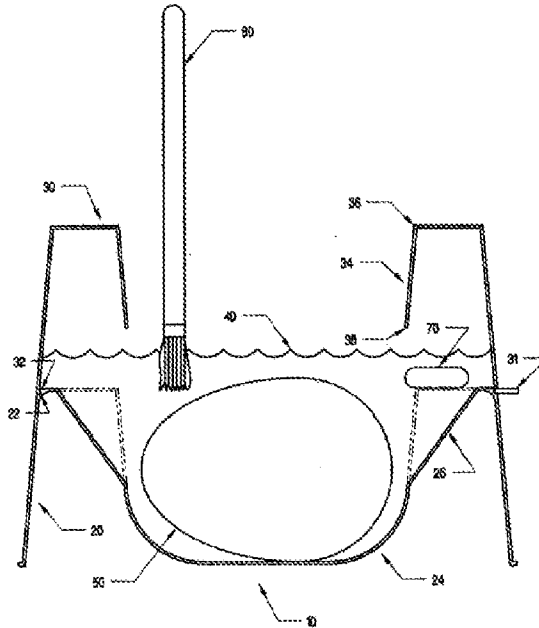


FIGURE 3

Figure 3 depicts a container assembly 10 including an egg 50 and a brush 60 (Spec. 6).

PRINCIPLE OF LAW

“[T]he definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

ANALYSIS

We do not agree with the Examiner that the recitation of “discreet” (claim 49) and “non-handle potion” (claims 22, 34, and 41) are indefinite. Though the Examiner alleges that (i) “it is unclear how [“discreet”] further limits the claimed objects”; and (ii) it is “unclear what a ‘potion’ encompasses” (Ans. 6-7), the Examiner has not provided sufficient rationale that the claim terms, in view of the Specification, would have been confusing to one skilled in the relevant art. *Moore*, 439 F.2d at 1235. The skilled artisan would have understood that the terms “discreet” and “potion” were merely typographical errors in view of Figure 3 of the Specification, which shows an edible article and non-edible article as two discrete unconnected objects and a brush having handle and non-handle portions (FF 3).

B. 35 U.S.C. §§ 102 and 103

III. Claims 21, 22, 24-28, 30-34, 36-45, and 47-51: Obviousness over Law, Schramm, Hunter, Martindale, Price, and JP ‘388

Appellant argues claims 21, 22, 24, 25, 27, 28, 30, 31, 33, 34, 36, 37, 39-43, 45, and 47-51 together and claims 26, 32, 38, and 44 together (App. Br. 9-12).⁵ Accordingly, we select claims 21 and 26 as representative of the appealed claims and confine our discussion to these selected claims. 37 C.F.R. § 41.37(c)(1)(vii).

⁵ With regard to claims 25, 31, 37 and 43 and claims 24, 30, 36, and 42, Appellant discusses the recited limitations, but does not argue for separate patentability of the claims (App. Br. 10-11).

The Examiner found, as to claim 21, that Law teaches every limitation, except “a funnel connected to said opening to provide communication between said inner cavity and the exterior of said container” (Ans. 10). To account for the difference, the Examiner relied on Schramm, Hunter, Martindale, Price, and JP ‘388, which are each said to teach a container with a funnel connected to the opening of the container to provide communication between the exterior and interior of the container while preventing spilling of flowable non-gaseous (solid or liquid) materials (Ans. 8-10.). The Examiner then concluded that it would have been obvious to one of ordinary skill in the art to substitute Lee’s container with a container having a funnel as taught by any of Schramm, Hunter, Martindale, Price, and JP ‘388 to prevent spills of flowable non-gaseous material from the containers (Ans. 10 and 11).

With regard to claim 26, the Examiner recognized that Law does not disclose the claimed flow channel (Ans. 10). However, the Examiner asserted that the limitation “at least one liquid flow channel formed in a wall of said container” does not establish how the flow channel relates to other structural elements of the container (*id.*). The Examiner then relied on a definition of “channel,” as “a passage for water (or other fluids) to flow through,” and asserted that “the wall of the container below the funnel and including the funnel of the Schramm, Hunter, Japan ‘388 . . . Martindale, [and] Price . . . container can serve as a flow channel” (Ans. 22).

Appellant, on the other hand, contends that there is no motivation to combine the cited references because although Law discloses spilling as a problem, Law attempts to solve the spilling problem by providing an egg crate structure (App. Br. 10). Further, Appellant asserts that a container that

provides ready access to a removable egg yet provides spill resistance of liquid contents is nonobvious, and that a container “having a funnel member of a size and shape that will allow for the passage of an egg is counterintuitive” (*id.*). Appellant contends that the Examiner erred because a container having a non-cylindrical/non-conical funnel has been patented (*id.*).

With regard to the rejection of claim 26, Appellant contends that the Examiner erred in finding that the cited references disclose the flow channel as claimed because the flow channel is limited to a channel “formed *within* a wall” and that “[i]f the entire wall (and even funnel) is to be considered the flow channel, then the so-called flow channel of the cited art cannot be formed within a wall” (*id.* at 11-12 emphasis added).

ISSUES

Thus, the issues arising from Appellant’s contentions are:

Has Appellant shown reversible error in the Examiner’s conclusion that it would have been obvious to one of ordinary skill in the art to substitute Law’s egg coloring containers with spill resistant containers having funnels, as taught by Schramm, Hunter, Martindale, Price, and JP ‘388, to arrive at the invention of claim 21?

Has Appellant shown reversible error in the Examiner’s finding that each of Schramm, Hunter, Martindale, Price, and JP ‘388 discloses the claimed subject matter of a container having a “liquid flow channel formed in a wall of said container,” as required in claim 26?

ADDITIONAL FINDINGS OF FACT (“FF”)

4. Law’s Figure 1 is reproduced below:

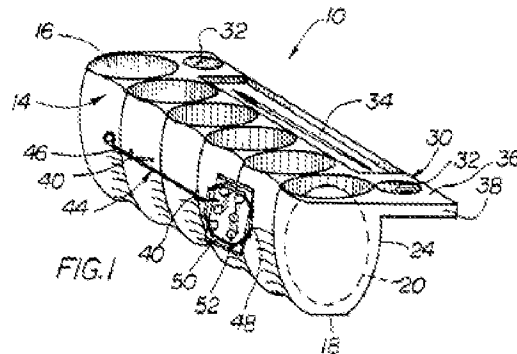
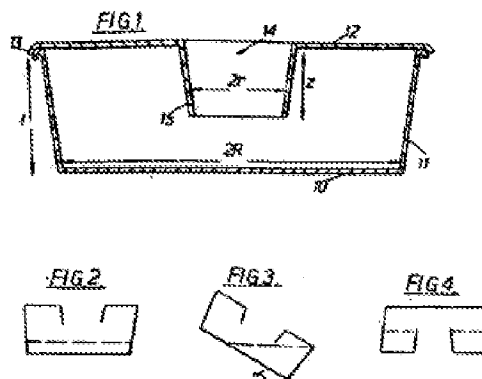


Figure 1 depicts a kit 10 including a dye chamber 14, an egg 20 (i.e., a work piece), brush (not labeled) and egg ladle 44 (i.e., utensils), and dye tablets 52 (i.e., colorant) (col. 3, ll. 8-10, 29-38, and 40-43).

5. Law discloses that it is known in the art of egg dyeing that spilling frequently occurs with traditional containers containing dye (col. 1, ll. 19-27).
6. Hunter’s Figures 1-4 are reproduced below:



Figures 1-4 depict a non-spill container having a collar 15 (i.e., funnel) so that fluent material (e.g., water and paint) within the

container will not spill when the container is tilted or inverted
(Hunter at 1, ll. 9-10, 19-25; 3, ll. 15-25).

PRINCIPLES OF LAW

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”
KSR Int’l Co. v. Teleflex, Inc., 550 U.S. 398, 416 (2007).

Adopted claim construction must be “reasonable in light of the totality of the written description.” *In re Baker Hughes Inc.*, 215 F.3d 1297, 1303 (Fed. Cir. 2000).

ANALYSIS

Claim 21

We are unpersuaded by Appellant’s contention that there is no motivation to combine the teachings of the prior art because Law is directed to a conventional egg coloring container and Schramm, Hunter, Martindale, Price, and JP ‘388 are directed to spill resistant containers.⁶ (See App. Br. 10). Law describes the problem of spilling associated with egg coloring containers (FF 5). Hunter teaches a container for fluid material (e.g., water and paint) having a funnel connected to the opening of the container so that the container is spill resistant when tilted or inverted (FF 6). Appellant has failed to demonstrate that when combining Hunter’s container with Law’s egg coloring kit (FF 4), one of ordinary skill in the art would not have

⁶ We confine our discussion to Law and Hunter, as the teachings of Schramm, Martindale, Price, and JP ‘388 are cumulative to Hunter’s teachings.

expected Hunter's container to maintain its function as a spill resistant container in a predictable manner. *See KSR*, 550 U.S. at 416. For these reasons, Appellant has not shown that the Examiner erred in concluding that claim 21 would have been obvious over Law, Schramm, Hunter, Martindale, Price, and JP '388.

We also find no persuasive merit in Appellant's contention that the Examiner erred because a container having a non-cylindrical/non-conical funnel has been patented (App. Br. 10). Claims must be adjudged as to patentability on the record in their own case. *See In re Wertheim*, 541 F.2d 257, 264 (CCPA 1976) ("it is immaterial in ex parte prosecution whether the same or similar claims have been allowed to others."); *see also In re Giolito*, 530 F.2d 397, 400 (CCPA 1976) ("We reject appellants' argument that the instant claims are allowable because similar claims have been allowed in a patent.").

Accordingly, we affirm the Examiner's rejection of claims 21, 22, 24, 25, 27, 28, 30, 31, 33, 34, 36, 37, 39-43, 45, and 47-51.

Appellant relies on the same arguments as set forth for claim 21 for the Examiner's rejection of claims 23, 29, and 35 over Law, Schramm, Hunter, Price, Martindale, JP '388, and Lintvedt (App. Br. 12) in Rejection IV. Accordingly, we affirm Rejection IV for the same reasons.

Claim 26

We do not agree with the Examiner that the claimed subject matter reads on a flow channel produced by the container wall and funnel disclosed in each of Schramm, Hunter, Martindale, Price, and JP '388 (Ans. 12 and 22). Claim 26 requires "at least one liquid flow channel formed in a wall of

said container.” As illustrated in Appellant’s Figure 2, the flow channels are formed in the container wall (FF 1). Therefore, one of ordinary skill in the art would have understood the claimed subject matter “liquid flow channel formed in a wall” requires a channel *in* the wall. Thus, the Examiner erred by interpreting the claims in a manner directly contrary to Appellant’s Specification. *See Baker Hughes Inc.*, 215 F.3d at 1303. Accordingly, we do not uphold the Examiner’s rejection of claims 26, 32, 38, and 44.

The Examiner relied on similar rationale in rejecting claims 38 and 44 under 35 U.S.C. § 102(b) as being anticipated by Price or McCombs in Rejections VI and IX respectively, and claim 44 under 35 U.S.C. § 102(e) as being anticipated by Martindale in Rejection XI. Accordingly, for these claims, we reverse the Examiner’s rejections for the same reasons.

V. Claims 47 and 48: Obviousness over Law, Schramm, Hunter, Price, Martindale, JP ‘388, and McShane

Appellant argues the appealed claims together (App. Br. 12). Accordingly, we select claim 47 as representative and confine our discussion to this selected claim. 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner found, as to claim 47, that the combined teachings of Law, Schramm, Hunter, Price, Martindale, and JP ‘388 fail to disclose that the funnel is non-annular (Ans. 12). To account for this difference, the Examiner relied on McShane, which is said to teach providing a non-annular opening of a container for dyeing eggs (Ans. 13). The Examiner concluded that it would have been obvious to one of ordinary skill in the art to modify the opening of the container with a connected funnel of any of Schramm, Hunter, Price, Martindale, and JP ‘388 as used in Law’s kit to be a non-

annular opening, as taught by McShane, to facilitate inserting an egg into the container (Ans. 12-13).

Appellant, on the other hand, asserts that McShane's teachings are directed to the overall shape of the container, not to a "non-annular funnel," as required by the claimed invention (App. Br. 12). In addition, Appellant contends that "a container having a 'non-cylindrical/non-conical funnel' (i.e., a non-annular funnel) has been held to be allowable by virtue of several patents" (App. Br. 12).

ISSUE

Thus, the issue arising from Appellant's contentions is:

Has Appellant shown reversible error in the Examiner's conclusion that one of ordinary skill in the art would have been led to modify the opening of a container having a connected funnel, as taught by the combined teachings of Law, Schramm, Hunter, Price, Martindale, and JP '388, to have a non-annular opening, in view of the teachings of McShane, thus arriving at the claimed invention of claim 47?

ADDITIONAL FINDINGS OF FACT ("FF")

7. McShane's Figure 1 is reproduced below:

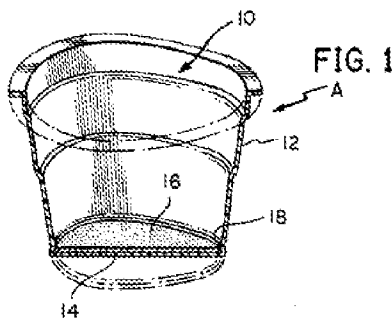


Figure 1 depicts a hemioval-shaped container for dyeing eggs (col. 3, 18-22; col. 6, ll. 60-64).

ANALYSIS

We find no merit in Appellant's contention that the Examiner erred because McShane discloses a non-annular overall container shape (FF 7) while the claim requires a non-annular funnel (App. Br. 12). Appellant has not submitted any persuasive evidence that it would have been beyond the skill of an artisan to modify the opening of the container and connected funnel of Schramm, Hunter, Price, Martindale, and JP '388, as used in Law's kit, to be non-annular. *See KSR*, 550 U.S. at 417 (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Appellant's contention that the Examiner erred because “a container having a ‘non-cylindrical/non-conical funnel’ (i.e., a non-annular funnel) has been held to be allowable by several patents including US RE39,443” is unpersuasive. As discussed above, “it is immaterial in *ex parte* prosecution whether the same or similar claims have been allowed to others.” *See Wertheim*, 541 F.2d at 264. *See also Giolito*, 530 F.2d at 400. Accordingly, Appellant failed to show that the Examiner erred in rejecting claims 47 and 48 as obvious over Law, Schramm, Hunter, Price, Martindale, JP '388 and McShane.

VI. Claims 34, 36, 38⁷, 39, and 47-49: Anticipation by Price

The Examiner found that Price discloses every limitation of the claimed invention (Ans. 12-14). With regard to claims 47 and 48, the Examiner found that “absent the new matter [i.e., the claimed subject matter lacking written description support under 35 U.S.C. § 112, ¶ 1] Price teaches every element of the claimed kit” (Ans. 13).

Appellant, on the other hand, contends, with regard to claim 34, that the limitation “non-fluid edible matter removably contained within said container” was not addressed by the Examiner (App. Br. 13). Appellant also asserts that the Examiner erred because Price does not disclose an edible article and a non-edible (or edible) utensil (App. Br. 13). Specifically, Appellant contends that Price teaches a single utensil comprising a spoon and an edible handle and that “absent the utensil itself, Price does not teach an edible article” (*id.*).

With regard to the rejection of claims 47 and 48, Appellant contends that Price teaches a conical funnel, not a “non-annular funnel,” as required by the claimed invention (App. Br. 13).

With regard to the rejection of claim 49, Appellant asserts that the claimed subject matter of “a non-edible utensil that is separate from and used in combination with an edible article” (i.e., “said edible article and said non-edible utensil define two discreet [sic] unconnected objects . . .”) distinguishes over Price, which merely discloses a singular utensil that is inserted and withdrawn from a container (*id.* at 13-14).

⁷ The Examiner’s rejection of claim 38 was reversed above. (*See* page 17).

ISSUES

Thus, the issues arising from Appellant's contentions are:

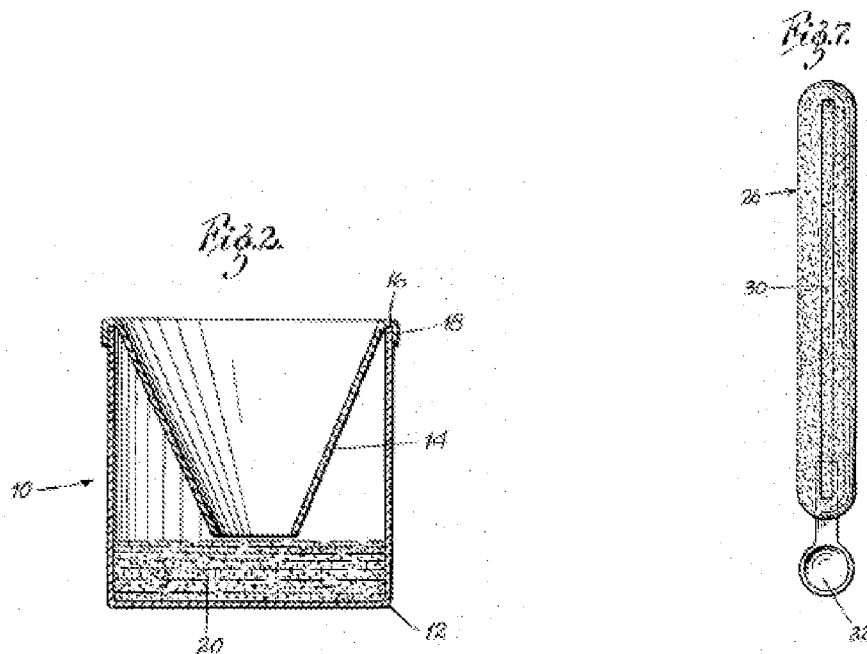
Has Appellant shown reversible error in the Examiner's finding that Price discloses a non-fluid edible matter removably contained in the container, as required by claim 34?

Has Appellant shown reversible error in the Examiner's finding that Price anticipates the claimed invention of claims 47 and 48, which includes "a non-annular funnel"?

Has Appellant shown reversible error in the Examiner's finding that Price discloses an edible article and a non-edible utensil that are unconnected, as required by claim 49?

ADDITIONAL FINDINGS OF FACT ("FF")

8. Price's Figures 2 and 7 are reproduced below:



Figures 2 and 7, respectively, depict a cup 10 having a cone 14 connected to the opening of the cup and a bread stick 26 having a spoon 32 extending from one end, wherein fluid food 20 (i.e., an edible article) that is contained in the cup may be removed from the cup by the bread stick or spoon and eaten (col. 1, ll. 34-40; col. 2, ll. 15-17).

9. Price discloses that the spoon is made of a non-edible material (col. 2, ll. 35-39).

PRINCIPLE OF LAW

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

ANALYSIS

Claims 34, 36, 39, and 49

Appellant submits separate specific arguments to claims 34 and 49. We address these arguments accordingly.

We agree with the Examiner that (i) Price’s figures plainly show a kit including a breadstick (i.e., a non-fluid edible matter) that is disclosed as removably contained within the container (Ans. 21; FF 8); and (ii) Price discloses a container with an amount of fluid food 20 (i.e., an edible article) therein that is unconnected to a non-edible spoon 32 (i.e., non-edible utensil) extending from the breadstick (Ans. 13; FF 8 and 9). Accordingly, we find no merit in Appellant’s contentions that (i) the Examiner has not addressed the limitation “non-fluid edible matter removably contained within said

container,” as required by claim 34; and (ii) Price does not disclose “an edible article and a non-edible utensil” that are unconnected, as required by claim 49.

We affirm the Examiner’s rejection of claims 34, 36, 39, and 49.

Appellant relies on the same arguments as set forth for claim 34 for the Examiner’s rejection of claim 35 over Price and Lintvedt in Rejection VII and claim 37 over Price and Schramm in Rejection VIII (App. Br. 14). Accordingly, we affirm Rejections VII and VIII for the same reasons.

Claims 47 and 48

We find merit in Appellant’s contentions that the Examiner erred in disregarding the limitation “a non-annular funnel,” as required in claims 47 and 48.

With regard to claims 47 and 48, the Examiner erred by disregarding the subject matter (i.e., “a non-annular funnel”) that the Examiner found lacked written description support in the originally filed Specification, but is recited in the claim. All claim limitations must be considered even if they were found not to be supported by the originally filed Specification. *See Ex parte Grasselli*, 231 USPQ 393, 394 (BPAI 1983). The Examiner did not direct us to any evidence that Price discloses a non-annular funnel. Accordingly, we find that the Examiner did not establish a prima facie case that Price anticipates claim 47 and its dependent claim 48.

IX. Claims 40-42, 44⁸, and 45: Anticipation by McCombs

Appellant groups claims 40-42, and 45 together and submits specific arguments directed to claim 40. (App. Br. 14-15). Accordingly, we select claim 40 as representative. 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner found, as to claim 40, that McCombs discloses every limitation of the claimed kit (Ans. 15). In particular, the Examiner found that McCombs describes a container that contains paint, which is a discrete article of colorant (*id.*).

Appellant, on the other hand, contends that McCombs does not disclose “a colorant tablet, a discrete article of colorant or a colorant pill . . .” as required in claim 40 (App. Br. 14-15).

ISSUE

Thus, the issue arising from Appellant’s contentions is:

Has Appellant shown reversible error in the Examiner’s finding that McCombs discloses a “colorant contained within said container . . . wherein said colorant defines at least one colorant of the following group of colorants consisting of a colorant tablet, a discrete article of colorant, and a colorant pill . . . ,” as required in claim 40?

⁸The Examiner’s rejection of claim 44 was reversed above. (*See* page 17).

ADDITIONAL FINDINGS OF FACT (“FF”)

10. McCombs’s Figure 2 is reproduced below:

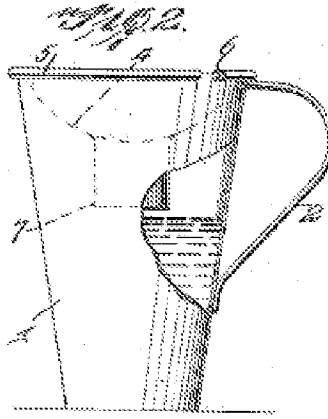


Figure 2 depicts a marking pot comprising a cup 1 having a cover 4 that includes a depending neck portion 7 (i.e., funnel) and that is connected to an opening of the cup (McCombs at 1, ll. 46-48, 64-67).

11. McCombs discloses that the marking pot is constructed to prevent spilling the liquid (i.e., paint or ink) contained in the cup should the cup be tilted or overturned (McCombs at 1, ll. 10-22 and 101-110).
12. The Examiner found that “colorant [is] defined by The American Heritage Dictionary of English Language, Second Ed. 1982, [as] ‘something, especially dye, pigment, ink or paint that modifies the color of something else’” (Ans. 15).

ANALYSIS

Claims 40-42 and 45

We find no merit in Appellant’s contention that McCombs fails to disclose a container containing “a discrete article of colorant . . . ,” as

required in claim 40 (App. Br. 14-15). Appellant does not direct us to any persuasive evidence that the Specification restricts the scope of the limitation “a discrete article of colorant.” Accordingly, we apply the broadest reasonable interpretation in accordance with the plain meaning of the limitation. *See In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). When the phrase “a discrete article of colorant” is given its broadest reasonable interpretation based on its plain meaning, one skilled in the art would have understood that the phrase encompasses a given amount of paint contained in a container. Therefore, “a discrete article of colorant” reads on McCombs’ spill resistant marking pot containing paint (FF 10 and 11) and is consistent with the Examiner’s cited dictionary definition that paint is a “colorant” (Ans. 15; FF 12). For these reasons, Appellant has not shown that the Examiner erred in rejecting claim 40 over McCombs.

Accordingly, we affirm the Examiner’s rejection of claims 40-42 and 45.

Appellant relies on the same arguments as set forth for claim 40 for the Examiner’s rejection of claim 43 over McCombs and Schramm in Rejection X (App. Br. 15). Accordingly, we affirm Rejection X for the same reasons.

XI. Claims 40 and 43-45⁹: Anticipation by Martindale

Appellant argues claims 40, 43, and 45 together, focusing on claim 40 (App. Br. 15-16). Accordingly, we select claim 40 as representative and confine our discussion to this selected claim. 37 C.F.R. § 41.37(c)(1)(vii).

⁹ The Examiner’s rejection of claim 44 was reversed above. (*See* page 17).

In support of this rejection, the Examiner found that Martindale teaches “at least one colorant of . . . a discrete article of colorant,” as recited in claim 40, because Martindale’s powder is a plurality of discrete articles of colorant (Ans. 16 and 21).

Appellant, on the other hand, contends that Martindale’s powder is not a “discrete article of colorant,” as required in claim 40 (App. Br. 15-16).

ISSUE

Thus, the issue arising from Appellant’s contentions is:

Has Appellant shown reversible error in the Examiner’s finding that Martindale discloses “at least one colorant of . . . a discrete article of colorant,” as required in claim 40?

ADDITIONAL FINDINGS OF FACT (“FF”)

13. Martindale’s Figure 1 is reproduced below:

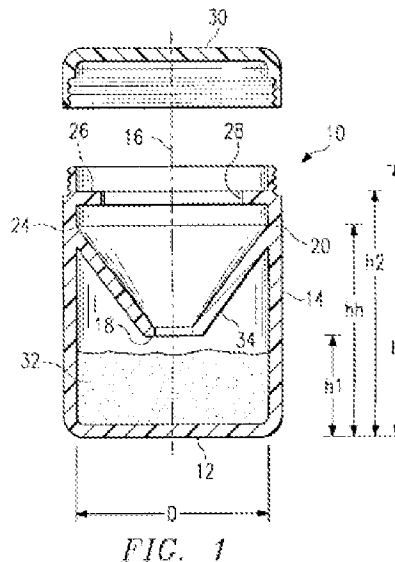


Figure 1 depicts a spill resistant container 10 having a retaining member 16 (i.e., funnel) and containing finely divided particles

of fingerprint powder (col. 1, ll. 12-13, 44-47; col. 2, l. 62 – col. 3, l. 1).

ANALYSIS

Claims 40, 43, and 45

Appellant contends, as to claim 40, that Martindale does not disclose a single discrete article of colorant (App. Br. 16). This contention fails from the outset because the claimed subject matter is not limited to a single discrete article. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“Many of appellant’s arguments fail from the outset because . . . they are not based on limitations appearing in the claims.”). The claimed invention requires, *inter alia*, a container containing “at least one colorant of the following group of colorants consisting of . . . a discrete article of colorant . . .” (claim 40). Thus, by reciting “at least one,” the claimed invention encompasses a plurality of discrete articles of colorant. Indeed, Appellant acknowledges that Martindale comprises “a plurality of colorant powder members” (App. Br. 16; FF 13). Accordingly, we are not persuaded by Appellant’s arguments.

We affirm the Examiner’s rejection of claims 40, 43, and 45.

Appellant relies on the same arguments as set forth for claim 40 for the Examiner’s rejection of claim 42 over Martindale in Rejection XII and claim 41 over Martindale and Lintvedt in Rejection XIII (App. Br. 16). Accordingly, we affirm Rejections XII and XIII for the same reasons.

XIV. Claims 52-54: Obviousness over Price and Meth

The Examiner found, as to claims 52-54, that Price discloses every limitation of the claims except for a well formed in the inner cavity of the container (Ans. 17-18). To account for this difference, the Examiner relied on Meth, which is said to teach a well formed in an inner cavity of a spill resistant container to receive a portion of an article (Ans. 18). The Examiner concluded that it would have been obvious to one of ordinary skill in the art to replace Price's non-spill container with Meth's non-spill container having a well to "provid[e] a quick food service item in a non-spill liquid container" (*id.*).

Appellant, on the other hand, contends that each of claims 52-54 distinguishes over Price and Meth because they include "at least one unique and nonobvious limitation that defines appellant's utensil and appellant's colorable work piece [claim 52] or appellant's article [claims 53 and 54] to define discrete unconnected items" (App. Br. 17).

ISSUE

Thus, the issue arising from Appellant's contentions is:

Has Appellant shown reversible error in the Examiner's findings that Price and Meth disclose every limitation of the claimed inventions, as required in claims 52-54?

ANALYSIS

Appellant contends that each of claims 52-54 distinguishes over the combined teachings of Price and Meth because the claims "include at least one unique and nonobvious limitation that defines appellant's utensil and . . . colorable work piece [claim 52] or . . . article [claims 53 and 54] to define

discrete unconnected items” (App. Br. 17). This contention has no merit because the claims do not require the utensil and either the work piece or the article to be “discrete unconnected items” (App. Br. 17). *See Self*, at 1349.

DECISION

We affirm the Examiner’s decision to reject:

claims 22-27, 34-39, 41, 47-51 under 35 U.S.C. § 112, first paragraph;

claims 21-25, 27-31, 33-37, 39-43, 45, and 47-54 under 35 U.S.C. § 103(a);

claims 34, 36, 39, 40-42, 45, and 49 under 35 U.S.C. § 102(b); and

claims 40, 43, and 45 under 35 U.S.C. § 102(e).

We reverse, however, the Examiner’s decision to reject:

claims 40 and 42-45 under 35 U.S.C. § 112, first paragraph;

claims 22-27, 34-39, 41, and 49 under 35 U.S.C. § 112, second paragraph;

claims 26, 32, 38, and 44 under 35 U.S.C. § 103(a);

claims 38, 44, 47, and 48 under 35 U.S.C. § 102(b); and

claim 44 under 35 U.S.C. § 102(e).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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tc

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